

### **REMARKS**

This Amendment After Final Rejection is responsive to the final Office Action identified above, and is further responsive in any other manner indicated below.

### **PENDING CLAIMS**

Claims 1-25 were pending, under consideration and subject to examination in the Office Action. Appropriate claims have been amended, canceled and/or added (without prejudice or disclaimer) in order to adjust a clarity and/or focus of Applicant's claimed invention. That is, such changes are unrelated to any prior art or scope adjustment and are simply refocused claims in which Applicant is presently interested. At entry of this paper, Claims 1-25 remain pending for consideration and examination in the application.

### **REJECTION UNDER §112, 2<sup>ND</sup> ¶ OBVIATED VIA CLAIM AMENDMENT**

Claims 2, 9, 21 and 23 have been rejected under 35 USC §112, 2<sup>ND</sup> ¶ as being indefinite for the concerns listed within the section numbered "2" on page 2 of the Office Action. Appropriate ones of such claims have been carefully reviewed and carefully amended where appropriate in order to address the Office Action listed concerns. As the foregoing is believed to have addressed all §112, 2<sup>ND</sup> ¶ concerns, reconsideration and withdrawal of the rejection are respectfully requested.

### **ALLOWED CLAIMS**

Claims 3, 4, 7, 15-17 and 22 are allowed in the application, as indicated within the section number "6" on page 4 of the final Office Action. Renewal of such

indication of allowance is respectfully requested. Applicant and the undersigned respectfully thank the Examiner for such indication of allowed subject matter.

**ALL REJECTIONS UNDER 35 USC §§102 AND 103 - TRAVERSED**

All 35 USC rejections are respectfully traversed. All descriptions of Applicant's disclosed and claimed invention, and all descriptions and rebuttal arguments regarding the applied prior art, as previously submitted by Applicant in any form, are repeated and incorporated herein by reference. Further, all Office Action statements regarding the prior art rejections are respectfully traversed. As additional arguments, Applicant respectfully submits the following.

At the outset, as to the requirements to support a rejection under 35 USC §102, reference is made to the decision of *In re Robertson*, 49 USPQ2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 USC §102 required that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the Court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the Court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 USC §103, reference is made to the decision *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under §103 to establish a *prima facie* case of obviousness, and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Furthermore, such requirements have been clarified in the recent decision in *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002), wherein the Court, in reversing an obviousness rejection, indicated that deficiencies of the cited reference cannot be remedied with conclusions about what is “basic knowledge” or “common knowledge.”

Thus, in order to properly support a §102 anticipatory-type rejection, any applied art reference must disclose each and every limitation of any rejected claim, and in order to properly support a §103 obviousness-type rejection, the reference not only must suggest the claimed features, but also must contain the motivation for modifying the art to arrive at an approximation of the claimed features. However, the cited art does not adequately support either a §102 anticipation-type rejection or a §103 obviousness-type rejection because it does not, at minimum, disclose (or suggest) the following limitations of Applicant's clarified claims.

Applicant's independent Claims 1 and 8 have been further clarified (without prejudice or disclaimer) to recite, in independent Claim 1, *e.g.*, “the static-side magnetic field adjusting means arranged at the uniform static magnetic field space side of the cooling vessel and not recessed into a volume defined between perimeter windings of either of the main superconductive coil or the adjusting superconductive

coil, so as to further adjust the magnetic field uniformity of the uniform static magnetic field space region.” It is respectfully submitted that the primary reference to Takeshima *et al.* (US 6,580,346 B1) does not disclose or suggest such arrangement, and in fact, it is respectfully submitted that the disclosure of Takeshima *et al.* actually teaches away from Applicant’s disclosed and claimed invention. More particularly, even assuming *arguendo* that FIG. 5 in Takeshima *et al.* includes recesses 52A and 52B which (assuming *arguendo* from Col. 8, lines 48-52 of Takeshima *et al.*) may accommodate the “magnetic field shimming means” of Takeshima *et al.*, even if such shimming means are placed within the recesses 52A or 52B of Takeshima *et al.*, it is respectfully submitted that at least portions of such shimming means will be recessed into a volume defined between perimeter windings of the superconductive coils 41A and/or 41B of Takeshima *et al.*

None of the other applied references cure the deficiencies discussed above with respect to the primary reference to Takeshima *et al.*

As a result of all of the foregoing, it is respectfully submitted that the applied art would not support a §102 anticipatory-type rejection or §103 obviousness-type rejection of Applicant’s claims. Accordingly, reconsideration and withdrawal of such §§102 and 103 rejections, and express written allowance of all of the rejected claims, are respectfully requested.

#### **RESERVATION OF RIGHTS**

It is respectfully submitted that any and all claim amendments and/or cancellations submitted within this paper and throughout prosecution of the present

application are without prejudice or disclaimer of any scope or subject matter.

Further, Applicant respectfully reserves all rights to file subsequent related application(s) (including reissue applications) directed to any/all previously claimed limitations/features which have been subsequently amended or cancelled, or to any/all limitations/features not yet claimed, *i.e.*, Applicant continues (indefinitely) to maintain no intention or desire to dedicate or surrender any limitations/features of subject matter of the present application to the public.

#### **EXAMINER INVITED TO TELEPHONE**

The Examiner is invited to telephone the undersigned at the local D.C. area number of 703-312-6600, to discuss an Examiner's Amendment or other suggested action for accelerating prosecution and moving the present application to allowance.

#### **CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully submits that all of the claims listed above as presently being under consideration in the application are in condition for allowance. Accordingly, allowance of such claims is respectfully requested.

This Amendment is being submitted within the shortened statutory period set by the 5 May 2004 final Office Action, and therefore, no Petition or fee is required for entry and consideration of this paper. To whatever other extent is actually appropriate, Applicant respectfully petitions the Commissioner for an extension of time under 37 CFR §1.136. No additional claim fees or other fees are required.

Please charge any actual and necessary deficiency in fees to ATS&K Deposit

Account No. 01-2135 (as Case 500.41391X00).

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Paul J. Skwierawski", is written over a horizontal line.

Paul J. Skwierawski  
Registration No. 32,173  
ANTONELLI, TERRY, STOUT & KRAUS, LLP  
1300 North Seventeenth Street, Suite 1800  
Arlington, Virginia 22209-3801, USA  
Telephone 703-312-6600  
Facsimile 703-312-6666